

REMARKS

Restriction requirement

The Examiner has restricted the pending claims to Invention I, encompassing claims 1-28, and to Invention II, encompassing claims 29-33. Only because Applicant is required to, Applicant hereby elects Invention I, encompassing claims 1-28, for immediate examination. Only to this end has Applicant thus withdrawn claims 29-33, encompassed by Invention II.

However, Applicant *strongly* traverses this restriction requirement, on two grounds. The first ground is that the combination as claimed in Invention II does in fact require the subcombination as claimed in Invention I. The Examiner has very selectively argued that independent claim 29 of Invention II does not require the limitations of claim 18 of Invention I. However, Applicant notes that Invention I covers all of claims 1-28, including independent claims 1, 16, and 22. It is a red herring to say that independent claim 29 of Invention II does not require the limitations of dependent claim 18 of Invention I, since in fact none of the independent claims 1, 16, and 22 of Invention I even require the limitations of dependent claim 18! That is, if the subcombination of Invention I does not require in the broadest claiming of this subcombination the limitations of dependent claim 18, then it cannot be said that the subcombination of Invention I is in fact limited to the limitations of dependent claim 18.

Therefore, the Examiner cannot say that the combination of Invention II does not require the limitations of claim 18 in arguing that the combination of Invention II does not require the subcombination of Invention I, where the subcombination of Invention I itself does not even require the limitations of claim 18! Indeed, claim 18 simply provides further limitations on independent claim 16, and therefore cannot be said to represent the subcombination of Invention I as a whole, since the limitations of claim 18 are essentially irrelevant to claims 1 and 22 of Invention I, which are not subject to claim 18 at all. The Examiner should have looked at the subcombination of Invention I as to the various independent claims 1, 16, and 12 in determining

whether the combination of Invention II requires the subcombination of Invention I – not selectively finding a single dependent claim of the subcombination of Invention I that is not found in the independent claim of the combination of Invention II.

In fact, dependent claim 18 of Invention I is at least substantially identical to dependent claim 30 of Invention II. Therefore, insofar as the subcombination of Invention I requires the limitations of claim 18 where claim 18 is a dependent claim, so does the combination of Invention II likewise require the limitations of corresponding claim 30 where claim 30 is a dependent claim. The Examiner has to compare apples to apples and oranges to oranges here – not apples to oranges as he has done via selectively finding a limitation of Invention I that does not even limit the entirety of Invention I, and then saying that this limitation is somehow not present in the entirety of Invention II. This is because, in fact, (1) this limitation is also not present in the entirety of Invention I; and, (2) this limitation is found Invention II *in the same way* that it is found in Invention I, as a dependent claim.

The Examiner is encouraged to contact Applicant's representative, Mike Dryja, at the phone number listed below, if he needs further clarification on this point. The Examiner is also encouraged to discuss this matter with his immediate supervisor. There is just no way that the restriction requirement proposed is proper based on the reasoning submitted by the Examiner – and the Examiner would surely lose if Applicant were to be forced to file an interlocutory appeal or petition to get the restriction requirement overturned.

The second ground on which Applicant traverses this restriction requirement is that Applicant submits that, as the claims are currently pending, the claims encompassed by Invention II are not patentably distinct over the claims encompassed by Invention I. In particular, Invention II recites a printing device that includes a particular type of subcombination including a display, a frame buffer memory, and a display data transfer circuit, where this particular type of display, frame buffer memory, and display data transfer circuit is that which is encompassed by Invention I. Insofar as this subcombination of Invention I is patentable, so too is Invention II

patentable. Likewise, insofar as this subcombination of Invention I is not patentable, so too is Invention II not patentable.

That is, the only thing that the claims of Invention II “add” to the subcombination of Invention I is the inclusion of such a subcombination specifically within a printing device. However, the printing device of Invention II is not distinctly patentable apart from its inclusion of this subcombination. That is, other than the limitations directed to the subcombination of Invention I, the broadest independent claim 29 of Invention II just recites a printing device having a printing mechanism by which the printing device is able to print images onto media, where claim 33 notes that this printing mechanism may be an inkjet-printing mechanism or a laser-printing mechanism. Applicant of course is not contending that the printing device’s inclusion of having an inkjet-printing mechanism or a laser-printing mechanism by itself patentably distinguishes Invention II of Invention I – laser-printing devices and inkjet-printing devices are obviously well known within the art. Rather, Applicant is contending that including the subcombination of Invention I into the printing device of Invention II is what gives Invention II its patentability. Thus, Invention II cannot be considered as patentably distinct over Invention I – if the subcombination of Invention I were ultimately held unpatentable, including this subcombination within a printing device having a printing mechanism as is done in Invention II would not otherwise render Invention II patentable.

Respectfully Submitted,



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